



TECHNOLOGY LAW UPDATE

JVW Enters., Inc.
v.
*Interact Accessories,
Inc.*

No. 04-1410

Federal Circuit
Oct. 3, 2005

[A] court may not construe a means-plus-function limitation “by adopting a function different from that explicitly recited in the claim.” [A] court errs “by importing the functions of a working device into the[] specific claims, rather than reading the claims for their meaning independent of any working embodiment.”

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On October 3, 2005, the Federal Circuit affirmed-in-part, reversed-in-part and remanded the district court’s judgment following a bench trial that Interact did not infringe U.S. Patent No. 4,494,754, which related to a video game controller. The Federal Circuit stated:

The construction of a means-plus-function limitation includes two steps. First, we determine the claimed function. Second, we identify the corresponding structure in the written description that performs that function. [T]he district court first construed the function of the means-plus-function limitation as “attached by a method whereby one can lock a game controller in place for use and can unlock and release the game controller after use,” but then “rephrased” its construction as “received in fixed position by the interlacing of fitting of parts into each other.” Because the district court’s infringement analysis does not appear to proceed under only one of the two versions of its construction, and, moreover, appears to involve both, we address both, beginning with the second.

The district court’s second construction confuses function with structure. Determining a claimed function and identifying structure corresponding to that function involve distinct, albeit related, steps that must occur in a particular order. In short, function must be determined before corresponding structure can be identified. [The district court] erred in its second construction.

As for the first construction, the district court seemed to recognize that that construction improperly adds unclaimed limitations to the function of the means-plus-function limitation. We agree. The first construction violated two tenets governing the determination of function in a means-plus-function limitation. First, a court may not construe a means-plus-function limitation “by adopting a function different from that explicitly recited in the claim.” Second, a court errs “by importing the functions of a working device into the[] specific claims, rather than reading the claims for their meaning independent of any working embodiment.” In construing the function to be “attached by a method whereby one can lock a game controller in place for use and can unlock and release the game controller after use,” the district court adopted unclaimed functions of “unlocking” and “releasing” the controller. Those functions are not recited explicitly in the claim but rather relate to a working embodiment disclosed in the ‘754 patent’s written description. [T]he function of “means for lockably receiving a video game controller in fixed position on said mounting member” [is] “receiving and locking a video game controller into a fixed position on the mounting member for use.”

The district court identified the structure associated with the “means for lockably receiving a video game controller in fixed position” as controller holders 21-24. “In order to qualify as corresponding, the structure must not only perform the claimed function, but the specification must clearly associate the structure with performance of the function.” Because neither party disagrees with the district court’s conclusion and we agree that the written description of the ‘754 patent clearly identifies controller holders 21-24 as corresponding structure linked to the function of “receiving and locking a video game controller into a fixed position on the mounting member for use,” we accept the district court’s identification of controller holders 21-24 as structure corresponding to the claimed function.